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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,074	10/06/2003	Arnold B. Finestone	82017-498	9939

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WINSTON & STRAWN
PATENT DEPARTMENT
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WASHINGTON, DC 20005-3502

EXAMINER	
JACKSON, MONIQUE R	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/680,074	FINESTONE ET AL.	
	Examiner	Art Unit	
	Monique R Jackson	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/03 & 1/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 7, 15, 18, 19 and 20 of U.S. Patent No. 6,235,386. Although the conflicting claims are not identical, they are not patentably distinct from each other because corona treatment of a film surface is a method to increase dynes and affinity to adhesive and wherein it would have been obvious to one skilled in the art to combine dependent limitations to produce the instantly claimed invention which would have the same properties as the instant invention given that the materials are the same. Further, though U.S. Patent No. 6,235,386 is directed a product, it clearly teaches a corona-treatment step and provides motivation within the claim limitations, such as lamination via a water-based adhesive, to produce the laminate as instantly claimed wherein it would have been within the ordinary skill of one in the art to determine the optimum production speed at which to produce the laminate.

3. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, and 9 of U.S. Patent No. 5,518,799. Although the conflicting claims are not identical, they are not patentably distinct from each other because it

would have been obvious to one skilled in the art to utilize any paper material wherein Kraft paper is a conventionally utilized paper substrate in the art, corona treatment of a film surface is a method to increase dynes and affinity to adhesive and wherein it would have been obvious to one skilled in the art to combine dependent limitations to produce the instantly claimed invention which would have the same properties as the instant invention given that the materials are the same. Further, though U.S. Patent No. 5,518,799 is directed a product, it clearly teaches a corona-treatment step, and a cold laminating step with a water based adhesive and hence provides motivation within the claim limitations to produce the laminate as instantly claimed wherein it would have been within the ordinary skill of one in the art to determine the optimum production speed at which to produce the laminate.

4. Claims 1-6 and 13-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 6-8 of U.S. Patent No. 5,786,064. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art to utilize any paper material wherein Kraft paper is a conventionally utilized paper substrate in the art, corona treatment of a film surface is a method to increase dynes and affinity to adhesive and wherein it would have been obvious to one skilled in the art to combine dependent limitations to produce the instantly claimed invention which would have the same properties as the instant invention given that the materials are the same. Further, though U.S. Patent No. 5,786,064 is directed a product, it clearly teaches a corona-treatment step, and a laminating step with a water based adhesive and hence provides motivation within the claim limitations to produce the laminate as

instantly claimed wherein it would have been within the ordinary skill of one in the art to determine the optimum production speed at which to produce the laminate.

5. Claims 1-6 and 13-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-9, 12, 14, and 16-21 of U.S. Patent No. 5,780,150. Although the conflicting claims are not identical, they are not patentably distinct from each other because corona treatment of a film surface is a method to increase dynes and affinity to adhesive and wherein it would have been obvious to one skilled in the art to combine dependent limitations to produce the instantly claimed invention which would have the same properties as the instant invention given that the materials are the same. Further, though U.S. Patent No. 5,780,150 is directed a product, it clearly teaches a corona-treatment step, and a laminating step with a water based adhesive and hence provides motivation within the claim limitations to produce the laminate as instantly claimed wherein it would have been within the ordinary skill of one in the art to determine the optimum production speed at which to produce the laminate.

6. Claims 1-6 and 13-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,565,252. Although the conflicting claims are not identical, they are not patentably distinct from each other because corona treatment of a film surface is a method to increase dynes and affinity to adhesive and wherein it would have been obvious to one skilled in the art to combine dependent limitations to produce the instantly claimed invention which would have the same properties as the instant invention given that the materials are the same. Further, though U.S. Patent No. 5,565,252 is directed a product, it clearly teaches a corona-treatment step, and a laminating step

with a water based adhesive and hence provides motivation within the claim limitations to produce the laminate as instantly claimed wherein it would have been within the ordinary skill of one in the art to determine the optimum production speed at which to produce the laminate.

7. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7 and 8 of U.S. Patent No. 5,244,702. Although the conflicting claims are not identical, they are not patentably distinct from each other because corona treatment of a film surface is a method to increase dynes and affinity to adhesive and wherein it would have been obvious to one skilled in the art to combine dependent limitations to produce the instantly claimed invention which would have the same properties as the instant invention given that the materials are the same. Further, though U.S. Patent No. 5,244,702 is directed a product, it clearly teaches a corona-treatment step and provides motivation within the claim limitations, such as lamination via a water-based adhesive, to produce the laminate as instantly claimed wherein it would have been within the ordinary skill of one in the art to determine the optimum production speed at which to produce the laminate.

8. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,652,984. Although the conflicting claims are not identical, they are not patentably distinct from each other because corona treatment of a film surface is a method to increase dynes and affinity to adhesive and wherein it would have been obvious to one skilled in the art to combine dependent limitations to produce the instantly claimed invention which would have the same properties as the instant invention given that the materials are the same. Further, it would have been within the ordinary

skill of one in the art to determine the optimum production speed at which to produce the laminate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monique R. Jackson
Primary Examiner
Technology Center 1700
April 30, 2004